FILE COPY

SEP 9 1948

CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No. 230

MINNESOTA MINING & MANUFACTURING COMPANY,
Petitioner,

against

INDUSTRIAL TAPE CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

DRURY W. COOPER,
ARNOLD S. WORFOLK,
HARRY W. LINDSEY, JR.,
Counsel to Respondent.

INDEX

PAGE

STATEMENT SUPPLEMENTARY TO PETITIONER'S SUMMARY STATEMENT OF THE MATTER INVOLVED 1

Francis Sales Device 2

Shuman Patent 2

Machine No. 50 3

Moore Patent 4

Simmons Patent 5

BRIEF

ARGUMENT 6

SUMMARY OF ARGUMENT 6

POINT A—The questions presented are moot unless the District Court's findings respecting the pleaded prior art are erroneous 6

POINT B—The questions presented are moot since they are not raised under the facts of this case 7

CONCLUSION 9

Table of Cases

PAGE

American Hide and Leather Splitting & Dressing Mach. Co. v. American Tool & Machine Co., Fed. Cas. No. 302 (1 Fed. Cas. 647, 654) 7

Blanchard v. Putnam, 8 Wall. 420 7

Brown v. Piper, 91 U. S. 37 8

Dey Time Register Co. v. W. H. Bundy Recording Co., C. C. A. 2, 178 F. 812, 818 7

Hendy v. Miner's Iron Works, 127 U. S. 370 8

M. Swift & Sons, Inc. v. W. H. Coe Mfg. Co., C. C. A. 1, 102 F. 2d 391, 393 7

National Biscuit Co. v. Crown Baking Co., C. C. A. 1, 105 F. 2d 422, 428 7

Slawson v. Grand St. P. P. & F. R. R. Co., 107 U. S. 649 8

Statutes and Rules

Section 69, Title 35; U. S. C. 7

Rule 8, Federal Rules of Civil Procedure 7

Rule 52(a), Federal Rules of Civil Procedure 6

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No. 230

MINNESOTA MINING & MANUFACTURING COMPANY,
Petitioner,

against

INDUSTRIAL TAPE CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Statement Supplementary to Petitioner's Summary Statement of the Matter Involved

The petition and brief of petitioner presents only a partial picture of what was decided in the District Court and affirmed by the Court of Appeals. Accordingly it is essential that a supplementary statement of the matter involved be made.

To show invalidity of the Borden patent in suit, respondent pleaded in its answer and offered evidence at the trial, The Francis Sales Co. dispenser, illustrated in Office Appliance Magazine, published September, 1908 (R. 325, 486), the Shuman patent 1,016,966 (R. 325, 472, 473,

474), the Moore patent 1,687,031 (R. 325, 480 to 485 incl.), the Simmons patent 1,608,344 (R. 325, 476, 477, 478), and the prior use Johnson & Johnson Machine No. 50 for winding tape upon individual cylinders or rolls (R. 39, 422 to 429 incl.).

The District Court found and concluded that the claims in suit were invalid in view of the pleaded prior art and completely anticipated by certain of the prior art disclosures (R. 452, 453, 454).

The Circuit Court of Appeals did not reverse the lower Court's findings with respect to the pleaded prior art. This art is described briefly below:

The Francis Sales Device

This device was designed to dispense gummed paper tape useful in sealing packages. It has a support for a roll of tape, a serrated cutting edge for severing desired lengths of tape, and between the serrated cutting edge and the roll support there is a surface to which the tape adheres in the act of cutting. This surface serves as a moistener when the device is used with gummed tape. Ample space between the surface and the roll support enables the tape to be grasped by the fingers for withdrawal from the roll (R. 310, 311, 312, 313, Finding 9, p. 453).

The Shuman Patent

This patent discloses a device for dispensing gummed adhesive tape. It is blanked out of sheet metal and bent to provide means for supporting a roll of adhesive tape. The tape-supporting means has synclinally disposed end walls to give a two point support to a roll of tape resting

therein. With this arrangement, the tape is prevented from unwinding too freely by the friction exerted at these points of support during the unwinding operation. The Shuman device has a severing edge and a surface positioned between the severing edge and the tape-supporting means to which the strip attaches. A moistening wick is provided since the gummed tape for which it was designed requires moistening. The friction type support in the Shuman device is not suitable for pressure-sensitive adhesive tape, but if it is equipped with a roll-supporting bearing similar to that in the earlier Francis Sales device to hold the roll of tape at the center, there is no difference between it and the device made under the patent in suit (R. 322, 323, 324, 325, Finding 13, p. 454).

Machine No. 50

This is a production machine which was used in the plant of Johnson & Johnson for many years prior to the advent of the Borden dispenser, for winding one-yard lengths of one-half inch and one inch widths of pressure-sensitive adhesive surgeon's tape on spools. In this machine, there is mounted in a standard at the rear, a large supply roll of tape, either one-half inch or one inch in width. The tape comes off the supply roll, passes beneath, and with its non-adhesive side in contact with, a guide roll, and then over, and with its adhesive side in contact with, a measuring wheel or drum whose circumference is a trifle over a yard.

In the peripheral surface of the measuring roll there is a transversely located severing knife and, adjacent and parallel thereto, a finger groove. Between the finger groove and the knife there is a surface to which the leading end

of the tape adheres after each cutting operation to hold the end of the tape in position for ready grasping by the operator.

In the use of the machine, the operator moves the index finger of her left hand along the finger groove and beneath the tape, lifts the end portion of the tape off the surface between the knife and the finger groove, and applies it to a spool which is located on a spindle in front of the measuring roll somewhat above the center thereof. As the machine cycle is inaugurated, the measuring roll and the spool are rotated in synchronism. Tape pulled off the roll at the rear is wound on the spool, and the amount to be wound is determined when the knife in the surface of the measuring roll has moved around to engage an overlying anvil roll and sever the tape. The remainder of the severed yard length continues to wind up on the spool while the leading end of the portion which remains on the measuring roll is brought around to the starting position, ready for the start of the next cycle (R. 37, 38, 39, Finding 12, p. 454).

The Moore Patent

This patent discloses a device designed to dispense zinc oxide plaster which is the pressure-sensitive adhesive surgeon's tape referred to in the Borden patent (R. 314). The Moore device has a shaft to support rolls of adhesive tape of any desired width. The tape is pulled off the roll and over a surface located at the top of the front wall of the device. Directly adjacent the surface at the front is a groove to accommodate a cutting knife. Since the Moore device is designed to cut cloth backed adhesive tape, the cutting knife is somewhat like a razor fastened to a mem-

ber which rides along the groove to cut off the desired length of tape. The knife cooperates with the front edge of the surface, much like the closing of a pair of scissors. The tape that remains after the cutting operation adheres to the surface at the rear of the groove (R. 314, 315. It is a complete anticipation. Finding 11, p. 453).

If another length of tape from the same roll is then desired, all that is necessary is to place the finger under the tape at the rear of the surface to which the tape has adhered, lift the tape off the surface, pull off the desired length and repeat the cutting operation.

The Simmons Patent

This patent discloses a dispenser for dental floss which may be round or flat, like a ribbon (R. 306). A roll of floss is mounted on a spindle inside the glass container. The floss ribbon is threaded up through a hole in the top of the container where it passes through a slit in a gasket-like sealing member. To dispense a piece of floss, the end is grasped and the desired amount pulled out. The floss is then pulled down over a cutting knife and severed. This knife is arranged at the front of the dispenser on the top (R. 320, 321). The slit in the sealing gasket is tight enough to resist unwinding during the severing operation. The floss is not pressure-sensitive and it has resiliency sufficient to make the end readily accessible for the next dispensing operation (R. 308). It left no room for patentability (R. p. 454, Finding 14).

ARGUMENT

Summary of Argument

A. The questions presented by the Petitioner are *moot*; because the Findings of Fact made by the District Court with respect to the Francis Sales Co. device, the Shuman patent, the Moore patent, the Simmons patent and Machine No. 50, and which were not reversed by the Circuit Court of Appeals, are dispositive of the controversy.

B. The questions presented by the petitioner are moot since the items of prior art not pleaded by respondent, but in view of which the patent in suit was held invalid, nevertheless were presented and explained to the Court, and introduced into evidence by petitioner as part of its prima facie case, in an effort to *sustain* the patent.

Point A

Any answer to the questions presented by petitioner for decision by this Court cannot affect the result of this litigation unless this Court also decides that the District Court erred in making the findings it did with respect to the pleaded prior art (R., 453-4). Rule 52(a) of the Federal Rules of Civil Procedure states that

> "* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *."

At the trial, respondent's expert testified to the effect that there are no differences between the Borden dispenser and those of the prior art other than what can be attributed

solely to mechanical skill (R. 312, 313, 325, 315, 316). There is no contradictory evidence in the case but, nevertheless, the plaintiff disputed the evidence of the defendant. Accordingly, there is no basis or reason for this Court to set aside the trial court's findings of invalidity of the Borden patent in view of the pleaded prior art.

Under the circumstances, the "questions" presented become moot.

Point B

The notice to plaintiff as to proof of previous inventions, knowledge or use of the thing patented, required to be given pursuant to Title 35, Sec. 69, U. S. Code, was for the purpose of preventing surprise at the trial, *Blanchard* v. *Putnam*, 8 Wall. 420. Whether or not Rule 8 of the Federal Rules of Civil Procedure has superseded that section of the code and requires such matters to be pleaded specially seems immaterial. The purpose of the requirement, if necessary, is essentially the same.

Under the code section, notice was not required where the prior use relied on was by the inventor or under his license, *American Hide and Leather Splitting & Dressing Machine Co.* v. *American Tool & Machine Co.*, Fed. Cas. No. 302 (1 Fed. Cas. 647, 654), or where such defense was developed on cross examination, *Dey Time Register Co.* v. *W. H. Bundy Recording Co.*, C. C. A. 2, 178 F. 812, 818; *National Biscuit Co.* v. *Crown Baking Co.*, C. C. A. 1, 105 F. 2d 422, 428; *M. Swift & Sons* v. *W. H. Coe Mfg. Co.*, C. C. A. 1, 102 F. 2d 391, 393. Under the same circumstances there should be no requirement of notice even if Rule 8 of the Federal Rules of Civil Procedure has superseded the code section.

Since the prior art McCarthy devices were offered by petitioner to show the state of the art, petitioner cannot complain if the District Court and the Court of Appeals found that Borden had contributed nothing of a patentable nature over McCarthy.

Whether or not respondent was lawfully required to give petitioner notice before or at the trial, of its intention to rely on the McCarthy device to invalidate the Borden patent is beside the point. What is important is the fact that both the District Court and the Court of Appeals did find the Borden patent invalid on the basis of *petitioner's proofs* on its *prima facie* case. The situation here is quite analogous to that in *Brown* v. *Piper*, 91 U. S. 37, *Slawson* v. *Grand Street P.P. & F.R.R. Co.*, 107 U. S. 649, and *Hendy* v. *Miner's Iron Works*, 127 U. S. 370. In all those cases, the patents involved were held invalid for lack of invention by this court, although the defense was not pleaded.

In the *Slawson* case, the Court said at page 652:

> "If letters patent are void because the device or contrivance described therein is not patentable, it is the duty of the court to dismiss the cause on that ground, whether the defense be made or not."

and again at page 654:

> "The facts of general knowledge of which we take judicial notice (*Taylor, Ev.*, Sec. 4, n. 2; *Brown* v. *Piper, ubi supra*) teach us that devices similar to this are as old as the use of reflectors."

In the three Supreme Court cases mentioned, the patents were held void because of the Court's knowledge of the

state of the art. Here too, the Borden patent was held void because of the Court's knowledge of the state of the art at the conclusion of petitioner's *prima facie* proofs.

CONCLUSION

The questions petitioner seeks this Court to pass upon are not material to the controversy because they are moot and because they are unsound. The petition should be denied.

Respectfully submitted,

DRURY W. COOPER,
ARNOLD S. WORPOLK,
HARRY W. LINDSEY, JR.,
Counsel to Respondent.

(P-4067)